

PATENT
Customer No.: 6980
Docket No.: STAT1130

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Owner: SIPC LLC) Group Art Unit: 2661
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Applicant: PETITE, Thomas D.) Examiner: SAM, PHIRIN
)
Patent No.: 6,914,893 (App. No.: 09/812,044)) Confirmation No: 9344
)
Issued: 5 JULY 2005) Docket No.: STAT1130
)
Title: SYSTEM AND METHOD FOR)
MONITORING AND CONTROLLING)
REMOTE DEVICES)

In accordance with 37 C.F.R. § 1.8, I certify that this correspondence is being transmitted to the Commissioner for Patents, MAIL STOP PETITION, P.O. Box 1450, Alexandria, VA 22313 via the USPTO's EFS-Web Electronic Filing System on 21 JANUARY 2009.

/jameshuntyanceyjr53809/
James Hunt Yancey, Jr., USPTO Reg. No. 53,809

PATENT OWNER'S RULE 183 PETITION REQUESTING CONFIRMATION OF THE PRIORITY CLAIM AMENDMENT SUBMITTED DURING PROSECUTION & ALTERNATIVE RULE 78 PETITION FOR ACCEPTANCE OF A PRIORITY CLAIM

Dear Honorable Sir:

Patent Owner submits this 37 C.F.R. § 1.183 Petition requesting the USPTO to confirm that the priority claim for this Patent is the one appearing on the face of USPN 6,914,893 (the "Patent"). Patent Owner alternatively submits this Rule 183 Petition requesting the USPTO to accept a priority claim for this Patent.

During prosecution of the Application issuing as the Patent, Primary Examiner Sam discovered a typographical error in the Application's priority claim – one of the parent application's serial number's contained a minor scrivener's error. Applicant corrected the scrivener's error in the priority claim as the Examiner suggested. Applicant believed the Examiner had authority to accept the modification, and the Patent issued with a priority claim that included the correct serial number for the parent application. Patent Owner believes that the Patent as printed contains a correct and valid priority claim, and files this Petition to confirm same out of abundance of caution in light of prosecution events.

I. Relevant Patent Prosecution History Facts¹

Counsel for Applicant T. David Petite filed the Application maturing into the Patent on 19 March 2001. When filed on 19 March 2001, the Application claimed priority to a number of parent patent applications. Unknown to Petite, at the time of filing the Application, the priority claim contained a typographical error. The application number for one of the parent applications contained a minor scrivener's error (herein referred to as the "typographical error"). (See Exhibit A, 37 C.F.R. § 1.132 Declaration of T. David Petite ("Petite Declaration"), ¶ 4).

Petite transferred the Application to the undersigned's firm while it was pending. (Petite Declaration, ¶ 5; *see also* Exhibit B, 37 C.F.R. § 1.132 Declaration of Ryan A. Schneider ("Schneider Declaration"), ¶¶ 2-3). At the undersigned's firm, Ryan A. Schneider, Esq. managed prosecution of the Application. (Schneider Declaration, ¶¶ 2-3). Unknown to Petite and Schneider, when the Application was transferred to the undersigned's firm, the Application's priority claim contained the typographical error. (Petite Declaration, ¶ 5; Schneider Declaration, ¶ 3).

Primary Examiner Sam examined the Application that issued as the Patent. Examiner Sam issued a first *Office Action* on 20 August 2004, and on page 2 of the *Office Action*, Examiner Sam identified the typographical error existing in the Application's priority claim. Only after reviewing the Examiner's *Office Action* did Petite and Schneider learn of the typographical error in the Application's priority claim. (Petite Declaration, ¶ 6; Schneider Declaration, ¶ 4). As the Examiner noted, the typographical error resulted from a substitution of "90" in the place of "04" in a parent application's serial number (the Application as filed referenced 09/790,150 but intended to reference 09/704,150). (Petite Declaration, ¶ 6; Schneider Declaration, ¶ 4). The Examiner discussed the informality the *Office Action* as follows:

1. The disclosure is objected to because of the following informalities:

The specification on page 1 indicates, "This application is a continuation-in-part of U.S. Patent Application Serial No. 09/790,150". After reviewing the application (09/790,150), the examiner believes that it does not relate[] to the instant application. However, the instant application relates to the U.S. Patent Application Serial No. 09/704,150. Therefore, the examiner requests the

¹ Patent Owner files herewith declarations providing factual background supporting this Petition. Factual citations to these declarations are provided herein. Patent Owner also refers to various portions of the Patent's file history.

applicant to review the instant application and make the appropriate correction [in] the specification if required and also file the petition for correction.

After issuance of Examiner Sam's *Office Action*, Schneider filed a 3 November 2004 *Response and Amendment* ("Response") on Petite's behalf. (Petite Declaration, ¶ 7; Schneider Declaration, ¶ 5). In this *Response*, Schneider submitted an amendment to clarify the typographical error appearing in the Application's priority claim. (Petite Declaration, ¶ 7; Schneider Declaration, ¶ 5). Due to the informal nature of the clarification and because Examiner Sam not only discovered the typographical error but mentioned the informality in the *Office Action*,² Schneider did not believe a "petition for correction" was necessary. (Schneider Declaration, ¶ 6).

After receiving the 3 November 2004 *Response*, Examiner Sam allowed the Application in a 27 December 2004 *Notice of Allowance*. In the *Notice of Allowance*, Examiner Sam fully allowed the Application, finding that the *Response* resolved all objections and rejections raised in the *Office Action*. The Examiner also accepted the clarification to the Application's priority claim by handwriting and initialing the change on a Bibliographic Data Sheet dated 27 December 2004. (Schneider Declaration, ¶ 7 and Attachment 1).³ Schneider believed that Examiner Sam's acceptance of the clarified priority claim amendment confirmed that the clarification made in the *Response* sufficiently corrected the typographical error appearing in the Application's priority claim. (Schneider Declaration, ¶ 7).

As a result of Examiner Sam's acceptance of the priority claim correction, the USPTO issued the Patent with reference to the correct priority application (09/704,150). Patent Owner believes this reference provides public notice to the correct priority claim. As shown on the cover page of USPN 6,914,893, the patent states that the Patent's priority

² While Patent Owner is unsure how Examiner Sam determined the application number to the parent application, Patent Owner believes that because Examiner Sam also examined the parent application, this is how Examiner Sam knew of the parent application's correct serial number.

³ Patent Owner believes that Examiner Sam also made a similar handwritten, initialed notation on a previous Bibliographic Data Sheet completed when initially examining the Application. Both Bibliographic Data Sheets are in the USPTO's electronic file wrapper for the Patent.

claim includes claim to “application No. 09/704,150, filed on Nov. 1, 2000.”⁴ The priority claim portion of the Patent also correctly identifies “US application No. 09/704,150, filed on Nov. 1, 2000” as a parent application. (See USPN 6,914,893, Column 1, Lines 7-8).

II. Rule 183 Petition To Formally Confirm The Priority Claim On The Patent's Face

Rule 183 enables parties to seek waiver of USPTO regulations in extraordinary situations. *See 37 C.F.R. § 1.183.* Patent Owner believes that the present situation presents an extraordinary situation. While Patent Owner believes that the Patent's priority claim is correct and valid based on the Examiner's acceptance of the priority claim amendment and the USPTO's printing of the Patent, Patent Owner nonetheless requests waiver of Rule 78(a)(3) should the USPTO deem it to apply. Patent Owner files this Petition out of an abundance of caution and seeks, if it is possible, to have the USPTO formally confirm the priority claim amendment recognized by Examiner Sam during prosecution and also printed on the Patent's face through this Petition filing.

Only in retrospect has it come to Patent Owner's attention that Examiner Sam may not have authorized the acceptance the priority claim amendment due to Rule 78(a)(3). This is notwithstanding that during prosecution of the Application, in the Notice of Allowance, and upon Patent issuance, all issues of the typographical error appears to be fully resolved. Since prosecution on the Application has long been closed, it is respectfully submitted that Patent Owner's recent awareness of Patent Owner's belief that Examiner Sam had inadvertently waived Rule 78(a)(3) by accepting amendments to the Application's priority claim raises an extraordinary situation for which Patent Owner can not find another suitable filing to confirm.

Should the USPTO's Petitions Office upon review of this Petition deem that Patent Owner was wrong to believe that Examiner Sam waived Rule 78(a)(3) or that Examiner Sam inadvertently waived Rule 78(a)(3), Patent Owner respectfully submits that the Patent's prosecution events present an extraordinary situation sufficient to waive Rule 78(a)(3). These events demonstrate that the Examiner clearly understood the correct serial number in the Application's priority claim. These events also demonstrate that the public notice function

⁴ The face of the Patent states that it is a “continuation” of application No. 09/704,150, and Patent Owner believes this is an inadvertent printing error. Patent Owner is in the process of requesting correction so that the Patent states it is a “continuation-in-part of application No. 09/704,150.” (See USPN 6,914,893, Column 1, Lines 7-8).

served by the Application's publicly available file history and by the printed Patent with the correct parent patent application number and the associated prosecution history clearly address the priority claim correction. The significant prosecution events weighing in favor of rule waiver and setting forth the required extraordinary situation include the following prosecution events:

- As evident in Examiner Sam's initial Application Bibliographic Data Sheet, when reviewing the Application in preparation of an *Office Action*, Examiner Sam discovered that the Application's priority claim contained a minor typographical error – Application Number "09/704,150" incorrectly typed as "09/790,150" – for one of the parent patent applications.
- In Examiner Sam's *Office Action*, the Examiner pointed Applicant to the correct priority patent application thereby showing that the Examiner clearly understood the correct priority patent application Application's priority claim intended to reference. The public has been aware of the correct priority claim since at least Examiner Sam's *Office Action* given that the Application's prosecution history became publicly available on 10 April 2003 (the Application's publication date).
- After Applicant clarified the Application's priority claim typographical error to refer to the priority patent application suggested by the Examiner, the Examiner allowed the Application finding that Applicant's *Response* sufficiently clarified the typographical error appearing in the Application's priority claim.
- Due to the minor nature of the typographical error appearing in the Application's priority claim as filed and the Examiner's discovery of same, Schneider did not believe a "petition for correction" was required because the Examiner cited no specific petition guidance and because "correction" petition filings are believed used to correct issued patents. (Schneider Declaration, ¶¶ 6-7).
- Since the Examiner accepted Schneider's correction to the priority claim and did not again raise the issue in the *Notice of Allowance*, Schneider believed that the typographical correction complied with USPTO regulations and no further action was required to correct the Application's initially filed priority claim with a scrivener's error. (Schneider Declaration, ¶ 7).
- When examining the Application and issuing the *Notice of Allowance*, Examiner Sam revised for a second time a Bibliographic Data Sheet for the Application such that Schneider believed that Examiner Sam accepted Applicant's correction to the Application's priority claim and showing that the Examiner clearly understood what priority patent application the Application's priority claim intended to reference. (Schneider Declaration, ¶ 7).

- The USPTO printed the correct priority application number on the face of the Patent thereby again accepting Applicant's correction to the Application's priority claim and providing full public notice of the Application's correct priority claim.
- All of the interaction between the Examiner and Applicant regarding the correction to the Application's priority claim is clear in the Patent's prosecution history thereby providing full public notice of the Patent's priority claim.

Patent Owner believes that the extraordinary events occurring during prosecution of the Application support waiver of Rule 78(a)(3) should the USPTO's Petitions Office deem the rule to apply here. Patent Owner believes that Examiner Sam correctly applied all USPTO regulations in accepting the clarifications to the Application's priority claim. Patent Owner also believes that prosecution events related to correction of the typographical error in the Application's priority claim comply with applicable USPTO regulations. Under Rule 183, Patent Owner respectfully seeks formal confirmation of the Patent's priority claim to Application Number 09/704,150 by waiving Rule 78(a)(3) (should it apply) or a declaration that the Patent's priority claim is valid and correct to confirm Patent Owner's belief.

III. Alternative Rule 78 Petition To Accept The Patent's Priority Claim Clarification

In the event that the USPTO's Petitions Office determines that: (a) Examiner Sam inadvertently waived Rule 78(a)(3) without authorization, or (b) that the Examiner did not waive the rule and Schneider should have known the Examiner could not officially correct the priority claim (even though the Patent issued with right priority claim information) and should have filed a petition, Patent Owner respectfully petitions pursuant to Rule 78(a)(3) for acceptance of a priority claim for the Patent. In accordance with Rule 78(a)(3), a grantable petition requires: (a) a reference required by 35 U.S.C. § 120 (unless previously submitted); (b) a surcharge fee; and (c) a statement that the entire delay between the date the claim was due as provided in Rule 78(a)(2)(ii) and the date the claim was filed was unintentional. *See 37 C.F.R. § 1.78(a)(3).*

Regarding the first two requirements (a) and (b), both have been satisfied. Indeed, during prosecution of the Application, a reference to the priority application (09/704,150) was submitted and this same reference is also displayed on the face of the Patent. Also, authorization to charge the required fee (if it is deemed due) is provided at the end of this submission.

Regarding the third requirement (c), Patent Owner believes this submission satisfies this requirement. Assuming Rule 78(a)(3) applies, Patent Owner's correction to the Application's

priority claim was believed due on 19 July 2001. As a first alternative, Patent Owner submits that the *Response* of 3 November 2004 is the date Patent Owner submitted the priority claim. Patent Owner respectfully submits that the entire delay in submitting the priority claim as of 3 November 2004 was unintentional. As a second alternative (and if deemed necessary for a grantable Petition), Patent Owner submits the priority claim submission is the filing date of this Petition. Patent Owner respectfully submits that the entire delay in submitting as of today's date was unintentional. Patent Owner submits the following facts showing that the entire delay of providing the priority claim was unintentional.

- When the Application was filed, Petite did not know that the Application's priority claim contained a minor typographical error. (Petite Declaration, ¶ 4).
- Prior to transferring the Application to the undersigned's firm during the fall of 2004, Petite's previous counsel did not raise the typographical error in the Application's priority claim or Examiner Sam's discovery of the typographical error to Petite. (Petite Declaration, ¶¶ 4-5).
- When Petite transferred the Application to the undersigned's firm during the fall of 2004, Petite and Schneider did not know that the Application's priority claim contained any error. (Petite Declaration, ¶ 5; Schneider Declaration, ¶ 3).
- Petite and Schneider were first made aware of the typographical error in the Application's priority claim when reviewing the Examiner's 20 August 2004 Office Action. (Petite Declaration, ¶ 6; Schneider Declaration, ¶ 4).
- In response to the Examiner's *Office Action* statements regarding the typographical error in the Application's priority claim, Schneider clarified the priority claim as suggested by the Examiner. (Schneider Declaration, ¶ 5).
- Schneider believed that Examiner Sam accepted the priority claim clarification by fully allowing the Application and also noting the priority claim clarification on a Bibliographic Data Sheet. (Schneider Declaration, ¶ 7).
- The USPTO issued the Patent with a reference to the correct priority application after Examiner Sam accepted the correction to the priority claim. (Schneider Declaration, ¶ 8).

- After receiving the issued Patent, Schneider's firm mailed the issued Patent to Petite for safekeeping and thereafter only recently spoke with Petite about the Patent. (Petite Declaration, ¶ 8; Schneider Declaration, ¶¶ 9-10).
- In recently reviewing the Patent and the Patent's prosecution history with litigation counsel in preparation for potential litigation, Petite learned that a potential issue existed with the Patent's priority claim. (Petite Declaration, ¶ 8).
- After consultation with Schneider regarding the potential priority claim issue, it was decided to file this submission out of an abundance of caution to address the potential issue with the Patent's priority claim. (Petite Declaration, ¶¶ 8-9; Schneider Declaration, ¶¶ 9-10).
- Schneider and his team then started preparing this submission and after finalizing this submission with consultation with Petite, filed this submission with the USPTO's Petitions Office. (Petite Declaration, ¶ 9; Schneider Declaration, ¶ 11).
- As a result, both Petite and Schneider acted with haste to ensure that any delay in submitting this submission was unintentional. (Petite Declaration, ¶ 9; Schneider Declaration, ¶ 11).

In sum, Patent Owner respectfully submits that any delay in submitting this paper to the USPTO was unintentional and thereby requests granting of this petition.

IV. Applicable Petition Fees

Patent Owner submits this Petition under 37 C.F.R. § 1.183 and alternatively under 37 C.F.R. § 1.78(a)(3). So that this Petition will be considered complete, Patent Owner pays the fee required by 37 C.F.R. § 1.17(f) (which is currently \$ 400). *See* 37 C.F.R. § 1.183.

Should the Petitions Office consider this Petition in the alternative under 37 C.F.R. § 1.78(a)(3), authorization is given to charge an additional \$1010 for the \$1410 fee required by 37 C.F.R. § 1.17(t) to Deposit Account No. 20-1507. *See* 37 C.F.R. § 1.78(a)(3).

No other fees are believed due. But the Commissioner is authorized to charge any fees deemed due to Deposit Account No. 20-1507 for full acceptance and consideration of this Petition.

V. Conclusion

Patent Owner submits this Petition in accordance with 37 C.F.R. § 1.183 and in the alternative under 37 C.F.R. § 1.78(a)(3). Patent Owner respectfully requests the Director to formally confirm the priority claim submitted during prosecution for this patent or alternatively accept a priority claim for this patent. While Patent Owner believes that the Patent as printed contains a correct and valid priority claim, Patent Owner files this Petition out of abundance of caution in light of prosecution events. Patent Owner seeks to have the Patent's priority claim accepted by Examiner Sam formally confirmed by the USPTO.

It is believed that this Petition is in proper form under both Rule 183 and Rule 78(a)(3). If, however, the USPTO deems this Petition to not be in proper form, the undersigned respectfully requests the USPTO to contact the undersigned at 404-885-3696. Patent Owner also invites USPTO Officials to telephone the undersigned with any questions or concerns regarding this Petition.

Respectfully submitted,

SIPCO, LLC

By: 
Thomas D. Petite, President

TROUTMAN SANDERS LLP

By: /jameshuntyanceyjr53809/
James Hunt "Hunter" Yancey, Jr.
USPTO Registration No. 53,809
Attorney for SIPCO LLC

TROUTMAN SANDERS LLP
5200 Bank of America Plaza
600 Peachtree Street, NE
Atlanta, Georgia 30308-2216
P: (404) 885-3696
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